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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/082,468 | 02/25/2002 | Shawn Domenic Loveland | 13768.254 | 4394 |
| 47973 | 7590 | 04/07/2005 | EXAMINER | |
| WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111 | | | SUAZO, RAINIER A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2144 | |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,468

Applicant(s)

LOVELAND ET AL.

Examiner

Rainier Suazo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/25/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims **1-34** are pending in this application.

Objections

2. The specification and the drawings were received on **02/25/2002**. These specification and the drawings are not acceptable. The specification and the drawing sheets do not have the appropriate margins (see 37 CFR 1.84(g)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims **1-5, 11-16, 21-27 and 30-34**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (U.S. 2002/0010748 A1), hereinafter 'Kobayashi' in view of Anderson et al. (U.S. 2002/0194307 A1) hereinafter referenced to as 'Anderson'.

Regarding claims **1, 11, 12, 21, 22, 23 and 30-34**, Kobayashi taught, In a network environment that includes a client that is network connectable to a server over a wireless network, the server configured to perform operations on documents on behalf of the user of the client, a method for the client causing an

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operation to be performed on the document while potentially conserving the bandwidth of the wireless network, the method comprising the following: an act of the client sending a document-inclusion instruction to the server, the document-inclusion instruction including an identification of the document, but not including the document itself ([0006, 0014-0017 and 0130]).

In addition Kobayashi taught that in the prior art related to the invention there is no necessity to transmit the attached file from the mail terminal to a mail server ([0006]). Kobayashi description denotes that sending the file instead of an identification was the conventional manner to achieve document transmission using electronic mail messaging systems; and that sending an identification to find the document was the newly conceived manner in the prior art described in Kobayashi's disclosure.

Kobayashi further taught executing the document inclusion instruction using the accessed document ([0094-0097, 0111 and 0125]; and figs. 3, 4 and 14).

Regarding particular details of claims 32 and 33, Kobayashi further taught the use of a mobile wireless device ([0002]). Kobayashi further taught the use of a server computer system (MTA or Mail Transfer Agent) connectable to a wireless device via a wireless network ([0004, 0007], "...The mobile Internet..."). Note that computer readable media and physical storage media are inherently disclosed in this arrangement. Kobayashi further taught the use of a local store with at least one document ([0006 and 0130]). Note that such local store is

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inherent in a client sending an attachment. Kobayashi further taught networking modules for network communication (**figs. 1, 18 and 21**).

Kobayashi did not expressively teach an act of the client receiving an indication that the document identified in the document-inclusion instruction is unavailable to the server. However, Kobayashi motivates the exploration of the art of electronic mail messaging (**[0002, 0005 and 0006]**).

Anderson taught an act of the client receiving an indication that the document identified in the document-inclusion instruction is unavailable to the server (**[0076-0077]**).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the methods/systems of Kobayashi with the teachings of Anderson in order to provide a negative indication respective to a document-inclusion instruction (**Anderson: [0076-0077]**). Although Kobayashi operation mode creates a list of files, to be presented to the user reading existing files, information systems are not infallible. *Kobayashi's disclosure would have resulted enhanced by the addition of error handling provided by Anderson* (**[0076-0077]**). One of ordinary skill in the art working with Kobayashi disclosure would have been motivated to explore the art of electronic mail messaging and addressing issues related to resources constrained devices such as PDA's (**[0004]**); which coincides with Anderson teachings (**[0002 and 0008]**). Therefore an act of the client sending a document-inclusion instruction to the server, the

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document-inclusion instruction including an identification of the document, but not including the document itself (**Kobayashi: [0006, 0014-0017 and 0130]**); an act of the client receiving an indication that the document identified in the document-inclusion instruction is unavailable to the server (**Anderson: [0076-0077]**) are expressively taught by the combination of Kobayashi and Anderson. Further, an act of the client sending the document to the server, to enable the server to complete a document-inclusion operation corresponding to the document-inclusion instruction, simply represents the conventional manner of operation, also taught by Kobayashi (**[0006]**).

Regarding claims **2, 3, 13, 14, 24 and 25**, Kobayashi taught sending the document-inclusion instruction in a new electronic mail message and forwarding an electronic mail message (**[0014 and 00130]**).

Regarding claims **4, 5, 15, 16, 26 and 27**, Anderson taught the calendar capabilities are were included in the range of capabilities offered by PDA's and other portable devices (**[0002]**). The examiner additionally notes that other portable devices include personal portable computers (laptops) with extended processing capabilities. It is further noticed that such portable devices such as laptop computers were commonly equipped with electronic mail clients such as MS Outlook® (MUA or Mail User Agent) to interface with electronic mail servers such as MS Exchange (MTA or Mail Transfer Agent). It is further noticed that MS Outlook® and MS Exchange provided document attachment capabilities in

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meeting requests at the time the instant invention was made. Since extending the attachment capabilities to other services provided by an email client was already well known in the art, extending document inclusion capabilities related to the elimination of attachments to such other services would be a matter of choice.

4. Claims **6, 7, 17, 18, 28 and 29**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (U.S. 2002/0010748 A1), hereinafter 'Kobayashi' in view of Anderson et al. (U.S. 2002/0194307 A1) hereinafter referenced to as 'Anderson'; and further in view of Watanabe et al. (U.S. 2001/0034774 A1) hereinafter 'Watanabe'.

Regarding claims **6, 7, 17, 18, 28 and 29**, the combination of Kobayashi and Anderson, hereinafter 'the combination', taught the invention substantially as claimed, including using the document-inclusion instructions to send a fax (see Kobayashi **[0174-0176]**). However the combination did not expressly teach details regarding printing in a particular printer using the document-inclusion instruction. Nevertheless, Kobayashi motivates the exploration of the art of sending an attached file to a specific fax address or number (**[0174-0176]**).

Watanabe taught receiving a document-inclusion instruction to print a particular document in a particular printer or a particular fax (**[0007-0009, 0011-0014, 0047-0050, 0073, 0108, 0109, 0117]**). In particular in paragraph 0011 Watanabe recites,

"According to another aspect of the present invention, a document transmitter is provided including a URL input screen transmitter that transmits a screen to input a URL to a

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cellular phone in response to a request from the cellular phone. A home page information acquirer receives a URL information from the cellular phone and accesses a webserver having the URL information to obtain home page information. A print instruction acquirer acquires print instruction information from the cellular phone. Then, a document transmitter transmits the home page information to a designated print destination in accordance with the print instruction information acquired by the print instruction acquirer."

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination with the teachings of Watanabe in order to provide specific functionality to print attached files and to fax attached files (**Watanabe: [0007-0009, 0011-0014, 0047-0050, 0073, 0108, 0109, 0117]** and **Kobayashi: [0174-0176]**). One of ordinary skill in the art working with the combination would be motivated to explore the art of using a wireless client to send document-inclusion instructions to send a fax (see Kobayashi **[0174-0176]**); which is also part of Watanabe disclosure as depicted in paragraphs **0011** and **0047-0050**. In a similar way one of ordinary skill in the art working with Watanabe would be motivated to explore the art of electronic mail messaging (**[0046]**); which is also part of the combination disclosure (see **Kobayashi: [0004]** and **Anderson: [0002 and 0008]**). Moreover Kobayashi's teachings regarding a fax "address" in paragraph **[0175]** are commensurate with the use of IPP disclosed by Watanabe in paragraph **[0108]**. Therefore, sending a document-inclusion instruction from a client to a server including specific instructions to print or fax a particular document corresponding to a document

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identification included in such instruction is taught by the combination modified with the teachings of Watanabe ([0007-0009, 0011-0014, 0047-0050, 0073, 0108, 0109, 0117]); *and would have provided enhanced results that including additional output options.*

5. Claims 8, 9, 10, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (U.S. 2002/0010748 A1), hereinafter 'Kobayashi' in view of Anderson et al. (U.S. 2002/0194307 A1) hereinafter referenced to as 'Anderson'; and further in view of LaRue et al. (U.S. 6,535,892 B1) hereinafter 'LaRue'.

Regarding claims 8, 9, 10, 19, 20 the combination of Kobayashi and Anderson, hereinafter 'the combination', taught the invention substantially as claimed, however the combination did not expressly teach details regarding a client and a server performing a version update process upon identifying that the requested version is unavailable. Nevertheless, the combination taught a client receiving a negative indication regarding a document-inclusion instruction **(Anderson: 0076-0077).**

LaRue taught a client that determines version conflicts between client and server versions of the same document, the client sending version indicator and

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the changes in comparison with the found version in order to synchronize a dataset (**column 12 line 48 to column 13 line 37**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the combination with the teachings of LaRue *in order to resolve version conflicts* (**column 12 line 48 to column 13 line 37**). Note that sending the whole document in a synchronization process is a normal procedure when document is not found at all, since there is no document to synchronize with. One of ordinary skill in the art working with the combination would be motivated to explore the art of electronic messaging and the use of portable devices to access a messaging system (**see Kobayashi: [0004] and Anderson: [0002 and 0008]**); which is also part of LaRue disclosure (**column 1 lines 59-64, column 2 lines 32-46 and column 3 lines 1-31**).

Therefore further combining the combination with the teachings of LaRue (**column 12 line 48 to column 13 line 37**) would provide a resolution mechanism to act in response to a negative notification, responsive to a document-inclusion instruction (**Anderson: 0076-0077**). *The combination would have resulted improved by adding an efficient method to further overcome problems entailed by a document not found error or an outdated version.*


Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892 for details.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rainier Suazo whose telephone number is (571) 272-3931. The examiner can normally be reached on Monday through Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rainier Suazo, MBA
Patent Examiner
Art Unit 2144


JACK D. HARNEY
SUPERVISOR, PATENT EXAMINER